



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

W

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,442	03/12/2004	Rainer Muller	5725.0864-01	5278
22852	7590	02/04/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			VENKAT, JYOTHSNA A	
		ART UNIT		PAPER NUMBER
		1615		

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/798,442	MULLER ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11/23/04.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 14-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 14-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Receipt is acknowledged of remarks filed on 11/23/04. Claims 14-37 are pending.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14-37 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. patent 6,143,286 ('286).

The claims are drawn to compositions. See col.16, line 10 for the range of the detergent base which is same as surfactant, see col.16, lines 15 et seq, col.16, and col.17, lines 1-27. See col.14, lines 29-30 for the range, which overlaps with the claimed liquid ester range, see col.14, lines 42 and 43 for the two species which are “isostearyl neopentanoate and tridecyl neopentanoate” which reads on the claimed liquid esters. These species reads on the claimed esters wherein R1 is tertiary butyl group and R2 is tridecyl or isostearoyl group. See col.2, lines 61-63 for the range of claimed adjuvant, which is also the claimed cationic polymers and see col.4, lines 34-35 for the claimed quaternary cellulose ether derivatives. See col.16, lines 13 for claimed adjuvants, which are silicones and vitamins.

Response to Arguments

3. Applicant's arguments filed 11/23/04 have been fully considered but they are not persuasive.

Art Unit: 1615

4. Applicants argue that the '286 patent does not expressly or inherently teach "at least one liquid ester obtained by reacting at least one C4-C6 carboxylic acid with at least one C12-C26 alcohol" as recited in, for example, Claim 14 of the present invention. (Emphasis added), instead, the '286 patent merely teaches that its composition "may additionally contain . . . an oily conditioning agent which is an organic, nonvolatile oil." at Col. 14, lines 28-31 (emphasis added) and the '286 patent teaches that "the oil may comprise esters of the formula RCO-OR' wherein R and R' are each independently a C1-25 chain at Col. 14, lines 37-40 (emphasis added) and therefore, the oily conditioning agent taught in the '286 patent, let alone the esters, is not a requisite component, but merely an optional component, and picking and choosing would be necessary to include any oily conditioning agent in the composition of the '286 patent.

5. In response to the above argument, it is the examiners position that the patent teaching oils at col.14 is not optional. Applicant's attention is drawn to the example 1 where the patent discloses isostearoyl citrate. This compound is an ester formed from citric acid, which is 6-carbon carboxylic acid and isostearyl alcohol, which has 18 carbon atoms. Applicant's attention is also drawn to example 2, which discloses oleyl alcohol, which is an oily component. See col.14, line 48 of the patent. . The patent clearly discloses esters and names 20 esters that is not a laundry list of esters. Therefore it is not picking and choosing the specific ester from the 20 compounds named under esters for " oily ". The 102 (e) rejection is deemed proper.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

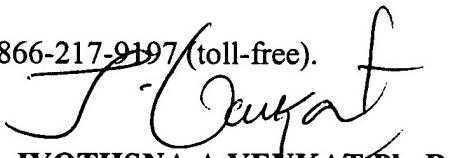
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
